



089844-0325373

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re the Application of: PETER ALSBERG ET AL. Serial No.: 09/726,573 Filed: December 1, 2000 For: METHODS AND SYSTEMS FOR MARKET CLEARANCE | Art Unit: 3624 Examiner: Campen, Kelly Scaggs |
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
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Sir:

Further to the Notice of Appeal filed herewith, and prior to the filing of an Appeal Brief, Applicants respectfully request review of the following rejections set forth in the final rejection mailed October 19, 2005 ("the Final Rejection"), and sustained by the Advisory Action mailed March 21, 2006: 1) claims 1-6 and 8-24 under 35 U.S.C. §101, and 2) claims 1-24 under 35 U.S.C. §102(e) over U.S. Patent 6,631,356 B1 to Van Horn et al. ("Van Horn").

On page 2 of the Final Rejection the examiner maintains that that "the claimed method consists solely of the manipulation of an abstract idea and is not concrete or tangible" and further maintains that "the claim is devoid of any limitation to a practical application in the technological arts."

As argued on page 10 of the Amendment After Final Rejection filed January 18, 2006 ("AAFR"), the recent In re Lundgren decision (BPAI Appeal No. 2003-2088) expressly strikes down any supposed "technological arts" ground of rejection under 35 U.S.C. §101. Moreover, all of the claims are directed to "computer-implemented" methods for matching received offers with one another. That is, the claims require, using a computer, receiving a plurality of offers,

considering them, and re-matching them in accordance with the claimed methodology. Consequently, all of the claims are indeed directed to statutory subject matter under §101 (including, of course, claim 7, which also recites computing technology, and was not so rejected).

Further, Applicants respectfully submit that the Examiner has failed to make a showing of how Van Horn anticipates each of the limitations of independent claims 1 and 16, and at least several of the dependent claims.

I. RECITED “OFFER CONDITIONS” - NOT DISCLOSED BY VAN HORN

As explained on page 13 of the AAFR, Van Horn discloses only one metric by which buyer offers are accepted or rejected, namely price. Van Horn describes aggregating potential buyers into an online “co-op” and is focused on demand or buyer aggregation through the co-op, wherein a single offer from a single seller at a starting price will trigger multiple buyer offers at the starting price, or below. No other conditions, beyond price, are included in Van Horn buyer offers.

In contrast, claim 1 requires conditions (i.e., plural conditions) of acceptance in connection with (advantaged) offers. These conditions might correspond to, for example, those recited in dependent claim 12, including a product specification, quantity specifications, pool specification and fragment list, among others. There is simply no notion of multiple conditions being required of buyer offers in Van Horn. Buyer offers in Van Horn are based on only a single metric, not plural metrics (or conditions). For this reason alone the claims of the present application should be allowable over Van Horn.

II. RECITED “ADVANTAGED OFFERS” AND “DISADVANTAGED OFFERS” - NOT DISCLOSED BY VAN HORN

As further explained on page 13 of the AAFR, the Examiner does not show how Van Horn discloses both of the recited “advantaged offers” and “disadvantaged offers.” As explained on page 11 of the AAFR, an advantaged offer is one that will necessarily be transacted upon (though not necessarily with the presently-matched disadvantaged offer), whereas a disadvantaged offer is one that may not be transacted upon, or more precisely, is eligible to be

disassociated from a corresponding advantaged offer with which it was previously matched. Van Horn discloses nothing about “advantaged” and “disadvantaged” offers, and the Examiner makes no attempt to explain how these limitations are allegedly anticipated by Van Horn.

III. RECITED “CHANGING THE ASSOCIATION OF AT LEAST ONE ASSOCIATED ADVANTAGED OFFER TO A NEWLY AVAILABLE DISADVANTAGED OFFER” - NOT DISCLOSED BY VAN HORN

As explained on page 14 of the AAFR, claim 1 requires re-associating (“changing”) an advantaged offer (e.g., a buyer offer) to a newly available disadvantaged offer (e.g., a seller offer) that offers more favorable terms. In the co-op system of Van Horn there is only ONE seller offer per co-op, and no more. Conversely, claim 1 requires a newly-available disadvantaged offer (i.e., one that comes in after a pair of offers (buy and sell) have already been associated). That is, claim 1 requires that there be at least TWO disadvantaged offers (e.g., seller offers) that are available at a given time (one that was originally associated, and another that will be newly associated). Nothing in Van Horn indicates that its co-op system can handle multiple buyer offers AND multiple seller offers. On the other hand, this is precisely the purpose of the instant invention as claimed: to handle multiple buyers and sellers, and allow them to come to different pricing and conditions agreements between each pair of matched offers.

The steps of first associating advantaged and disadvantaged offers and then changing the association of advantaged and disadvantaged offers to a newly available disadvantaged offer is fundamental to the present invention. However, this methodology is neither described nor contemplated by Van Horn.

DEPENDENT CLAIMS

As discussed on pages 14-16 of the AAFR, Van Horn is clearly deficient in disclosing several of the features recited in the dependent claims.

Claim 3 recites applying attributes of one of the advantaged offers to a price function of the disadvantaged offer to calculate a price. In other words, multiple attributes of advantaged offers are used as inputs to a price function of a disadvantaged offer to calculate price. No such functionality is disclosed in Van Horn since Van Horn does not consider multiple attributes, or any attribute beyond price.

Claim 5 recites applying a weighting function to the calculated price of dependent claim 3. Again, Van Horn is silent regarding this type of functionality.

Claim 10 recites that associating is performed in “order of priority” of the advantaged offers, such priority being “determined by the order in which the advantaged offers were received.” That is, the timing of when a particular offer is received is used as a metric in determining how to associate that offer. Van Horn discloses absolutely nothing about monitoring, or relying in any way on, the order in which offers are received. When timing is relied upon for causing matching, one can easily appreciate how different pairs of matched offers can settle at different prices, for example. In Van Horn in contrast, all buyers always receive the same price.

Claim 17 requires a transaction description including a “stepped-price schedule” and generating an uninterrupted sequence of offers, each corresponding to a price step in the stepped-price schedule. Van Horn is totally silent with respect to this subject matter.

Claim 21 introduces a specified “straddle limit” that is included in the transaction. Van Horn makes no mention of straddles (which require multiple disadvantaged offers).

Claim 22 (which depends from claim 21) requires monitoring the marketplace and adding an offer corresponding to the straddle. Again, Van Horn is devoid of any description of straddles, let alone adding offers in response to a straddle position.

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From the foregoing, it is quite apparent that Van Horn lacks disclosure of basic process steps required by the claims in the instant application. As such, a rejection of the pending claims of this application under §102(e) based on Van Horn cannot be sustained. Therefore, withdrawal of the rejection is strongly urged.

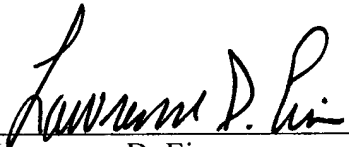
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Respectfully submitted,

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